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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/795,830	03/08/2004	James E. Grimm	0104-0060 (ZM0618)	2799

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EXAMINER

REIMERS, ANNETTE R

ART UNIT	PAPER NUMBER
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3733

DATE MAILED: 11/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/795,830

Applicant(s)

GRIMM ET AL.

Examiner

Annette R. Reimers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-26 is/are pending in the application.
- 4a) Of the above claim(s) 5-7, 20, 22, 24 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4, 8-13, 15-19, 21, 23 and 25 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>03/08/04, 08/21/06, 08/30/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election in the reply filed on September 19, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Examiner acknowledges applicant's cancellation of claim 1 and amendments to claims 2-4 and 8-14 to have the claims depend from claim 15. Examiner further acknowledges applicant's election of figures 5-6 (orthopaedic guide) and figure 7 (surgical component).

Examiner also acknowledges that applicant believes that claims 2-4, 8-19, 21, 23 and 25 read on the elected invention/species. Examiner agrees with applicant that claims 2-4, 8-19, 21, 23 and 25 read on the elected invention/species. Examiner also agrees with applicant that claims 2-4, 15-19, 21 and 25 appear to be generic.

Claims 5-7, 20, 22, 24 and 26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention/species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on September 19, 2006.

Specification

The abstract of the disclosure is objected to because it is too short. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 2-4, 8-13, 15-19, 21, 23 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Grimm et al. (US Patent Publication Number 20040122305), cited by applicant.

The applied reference has common inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Grimm et al. disclose a surgical system for use during an orthopaedic surgical procedure at a surgical site of a patient's body, the system comprising a surgical navigation system including means for tracking the position of an object during a surgical procedure, a navigated orthopaedic guide including means for being tracked by the surgical navigation system to guide positioning of the orthopaedic guide at a desired position relative to the surgical site, the orthopaedic guide including means for establishing a datum at a desired position relative to the surgical site; and a surgical component including means for engaging the datum positioned by the orthopaedic guide to locate the surgical component at a desired position relative to the surgical site, wherein the means for tracking comprises multiple sensors to detect and triangulate the position of the orthopaedic guide, wherein the means for being tracked comprises an electromagnetic coil attached to the orthopaedic guide, the electromagnetic coil producing a signal detectable by the means for tracking (see paragraphs 0004-0008 and 0049-0056), wherein the means for establishing a datum comprises a drill guide to guide a drill in forming a hole in a bone at the surgical site (see paragraph 0004), wherein the means for establishing a datum comprises at least one hole in the

orthopaedic guide/datum guide member, e.g. 20, to guide placement of a pin adjacent the surgical site (see figures 1-3), wherein the surgical component comprises a cut guide, e.g. 132, to guide a cutter to cut a bone to receive an implant, wherein the cut guide comprises a distal femoral cut guide, wherein the means for engaging the datum comprises at least one hole formed in the surgical component to receive the datum in the form of a pin (see figures 1-3), wherein the means for establishing a datum comprises means for establishing one or more datums relative to the surgical site selected from the list consisting of pins, screws, bars, fins, rails, dovetails, planar surfaces, holes, slots, and/or notches (see figures 1-3), wherein the means for establishing a datum comprises means for establishing an intermediate datum separate from the guide itself (see paragraph 0064), wherein the means for establishing a datum comprises a guide body including a plurality of holes through the body for guiding the placement of pins relative to the surgical site (see figures 1-3), wherein the means for establishing a datum includes a base member, e.g. 130, connected the datum guide member, e.g. 20, such that the position of the datum guide member is adjustable relative to the base member to a desired datum guide member position as indicated by the surgical navigation system (see paragraph 0060-0065), wherein the base member is able to be secured to a distal portion of a femur and the datum guide member is adjustable relative to the base member to establish a datum having desired flexion-extension and varus-valgus angles as indicated by the surgical navigation system (see paragraph 0064-0065) wherein the base member is able to be secured to a proximal portion of a tibia and the datum guide member is adjustable relative to the base member

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to establish a datum having desired posterior slope and varus-valgus angles as indicated by the surgical navigation system (see paragraph 0064-0065), wherein the means for establishing a datum comprises a base member, e.g. 130, defining a first adjustment axis, a connecting link, e.g. 36, mounted for rotation about and translation along the first adjustment axis, the connecting link defining a second adjustment axis, and a guide member, e.g. 22, mounted for rotation about and translation perpendicular to the second guide axis, further comprising locking means, e.g. 76, for locking the connecting link relative to the first adjustment axis and the guide member relative to the second adjustment axis, wherein the first adjustment axis is defined by a cylindrical bore formed transversely through an adjustment member, the connecting link including a cylindrical shaft engageable with the cylindrical bore for rotation within and translation along the cylindrical bore, the adjustment member being able to be pulled transversely relative to the first adjustment axis to clamp the cylindrical shaft in a locked position (see figures 1-3 and 7 and paragraphs 0060-0065).

Allowable Subject Matter

Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO 892 for art cited of interest.

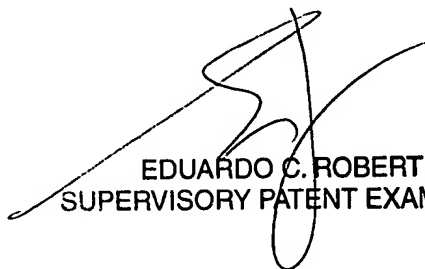
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette R. Reimers whose telephone number is (571) 272-7135. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER